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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,189	11/20/2003	Tsutomu Okada	17272	9810
23389	7590 10/10/2006		EXAMINER	
	OTT MURPHY & PI CITY PLAZA	VRETTAKOS, PETER J		
SUITE 300	CITT PLAZA		ART UNIT	PAPER NUMBER
GARDEN CIT	Y, NY 11530		3739	
			DATE MAILED: 10/10/2000	6

Please find below and/or attached an Office communication concerning this application or proceeding.

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	Application No.	Applicant(s)				
Office Antique Communication	10/718,189	OKADA, TSUTOMU				
Office Action Summary	Examiner	' Art Unit				
	Peter J. Vrettakos	3739				
The MAILING DATE of this communication app Period for Reply	pears on the cover sheet with	the correspondence address				
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING D. - Extensions of time may be available under the provisions of 37 CFR 1.1 after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period v. - Failure to reply within the set or extended period for reply will, by statute Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNIC, 36(a). In no event, however, may a repwill apply and will expire SIX (6) MONTH, cause the application to become ABA	ATION. ly be timely filed AS from the mailing date of this communication NDONED (35 U.S.C. § 133).	•			
Status						
1) Responsive to communication(s) filed on 15 S	<u>eptember 2006</u> .	•				
<u>, </u>	This action is FINAL . 2b)⊠ This action is non-final.					
	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is					
closed in accordance with the practice under E	x parte Quayle, 1935 C.D.	11, 453 O.G. 213.				
Disposition of Claims						
4) ⊠ Claim(s) <u>59-71</u> is/are pending in the application 4a) Of the above claim(s) is/are withdray 5) □ Claim(s) is/are allowed. 6) ⊠ Claim(s) <u>59-71</u> is/are rejected. 7) □ Claim(s) is/are objected to. 8) □ Claim(s) are subject to restriction and/o	wn from consideration.					
Application Papers						
9) The specification is objected to by the Examine 10) The drawing(s) filed on is/are: a) acc Applicant may not request that any objection to the Replacement drawing sheet(s) including the correct 11) The oath or declaration is objected to by the Examine 10.	epted or b) objected to by drawing(s) be held in abeyanction is required if the drawing(s	e. See 37 CFR 1.85(a).) is objected to. See 37 CFR 1.121(d	d).			
Priority under 35 U.S.C. § 119						
12) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of: 1. Certified copies of the priority document 2. Certified copies of the priority document 3. Copies of the certified copies of the priority application from the International Bureau * See the attached detailed Office action for a list	s have been received. s have been received in Ap rity documents have been re u (PCT Rule 17.2(a)).	plication No eceived in this National Stage				
Attachment(s) 1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO/SB/08)		mmary (PTO-413) Mail Date omal Patent Application				
Paper No(s)/Mail Date	6) 🔲 Other:	•				

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DETAILED ACTION

RCE filed 9-15-06.

The action is non-final.

Pending claims are 59-71.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 59-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kittur et al. (5,846,241).

Kittur discloses a sheath/main body member (10), an elongated member (28), a tip end (see fig 8), insulating section (25 and 50), first electrode (24'), second electrode (34'), a central axis that runs longitudinal of the device, external portion (figure 8), and conductive wires (16, 20).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to optimize Kittur through, amongst other things, rearrangement of parts (see response to arguments section below) **motivation** provided in MPEP § 2144.05 II. A. referring to *In re Peterson*, 315 F.3d at 1330, 65 USPQ2d at 1382, "The normal desire of scientists or artisans to improve upon what is already generally known

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provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages."

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Response to Arguments

Applicant's arguments filed 9-15-06 have been fully considered but they are not persuasive. Applicant argues that electrodes are not provided opposite to each other as disclosed in Kittur (5,846,241). However, this argument addresses a simple difference (between the claims and the art) in placement of structure, which is addressed in MPEP § 2144.04VI.C. excerpted below.

2144.04 VI. C. Rearrangement of Parts

In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device.); In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice).

Applicant argues that Kittur discloses a different method of use. However, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Kittur makes obvious the Applicant's structure and as such, is **capable** of the Applicant's method of use.

Applicant argues that Kittur does not disclose an integral elongated member and electrode. The MPEP addresses this as well:

2144.04 V.B. Making Integral

In re Larson, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (A claim to a fluid transporting vehicle was rejected as obvious over a prior art reference which differed from the prior art in claiming a brake drum integral with a clamping means, whereas the brake disc and clamp of the prior art comprise several parts rigidly secured

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together as a single unit. The court affirmed the rejection holding, among other reasons, "that the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice.").

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Vrettakos whose telephone number is 571-272-4775. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pete Vrettakos September 29, 2006

ROY D/GIBSON

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